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Response to Office Action of 13 May 2003

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Remarks

- 1) Claims 3 - 46 were pending in the case.

By an Office Action mailed October 18, 2002, a formal rejection under 35 USC 112 was made against claim 4. The Examiner made further rejections under 35 USC 102 of claims 3, 7 and 12 in light of Johnson '153 and claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 in light of Black, Jr., et al. Further rejections under 35 USC 103 of claims 4-7 were made in light of Johnson '153 in view of Russel; claim 8 was rejected in light of Black, Jr., et al., in view of Bell et al. '426; and claims 12, 18 and 28 were rejected in light of Black, Jr., et al., in view of Thompson '478.

In the detailed action, the drawings were objected to for failing to show all features identified in the specification and claims. The Examiner indicated that claims 8, 11, 16, 17, 19, 21, 22 and 27 would be allowable if rewritten in independent form.

The Applicant replied to this Office Action in a Response to Office Action submitted March 18, 2003.

Notwithstanding the Applicant's arguments presented in the Response to Office Action of March 18, 2003, by the further office action of May 13, 2003 the Examiner has:

- (a) rejected claim 4 on the basis of informality, presumably under 35 USC 112;
- (b) withdrawn the former rejections under 35 USC 102 of claims 3, 7 and 12 in light of US Patent 3,161,153 of Johnson;
- (c) again rejected claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 under 35 USC 102 in light of Black, Jr., et al.
- (d) withdrawn the former rejections under 35 USC 103 of claims 4-7 in light of Johnson '153 in view of US Patent 2,788,751 of Russel;
- (e) withdrawn the former rejection under 35 USC 103 of claim 8 given of Black, Jr., et al., (above) in view of US Patent 4,721,426 of Bell et al.;
- (f) newly rejected claim 8, and repeated the rejections of claims 12, 18 and 28 under 35 USC 103 in light of Black, Jr., et al., in view of US Patent 3,195,478 of Thompson; and

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- (g) again indicated the allowability of claims 11, 16, 17, 19, 21, 22 and 27 if rewritten in independent form.
- 2) Correction of Previous Commentary

It has come to the applicant's attention that the commentary of the Response to Office Action of March 18, 2003 notes at page 15, lines 14 - 17 under heading (iv) "Black, Jr. Teaches Against the Invention" is partially incorrect, namely at lines 14 - 17, the reference "Black, Jr.," should be deleted, and the reference --- Thompson --- should be inserted in three places.

3) Office Action Improperly Made "Final"

The applicant respectfully submits that the Office Action of May 13, 2003 was improperly made final for any one of the following reasons:

- (a) The Office Action does not state any basis upon which it is made "Final".
- (b) Contrary to USPTO procedure, new grounds of rejection have been raised against at least claims 4 and 8 that could have, and should have, been raised in the Office Action of October 18, 2002, without affording the applicant a full and fair non-final opportunity to respond to those rejections.
- (c) Contrary to USPTO procedure new grounds of rejection have been raised against at least claims 4 and 8 that were not necessitated by the Applicant's response to office action, and for which the applicant has not had a non-final opportunity to present a full and fair response by way of argument, amendment, or both argument and amendment.
- (d) In repeating a rejection, the Examiner has not fully addressed the arguments presented by the Applicant, contrary to the requirements of MPEP 707.07 (g).
- (e) The Examiner had previously both rejected and allowed claim 8, was requested to provide clarification, and has not provided clarification in a non-final Office Action, as the Examiner is required to do.

The applicant therefore respectfully requests that the making "Final" of the Office Action of May 13, 2003 be withdrawn, and that either the claims be allowed or a new, properly prepared, non-final Office Action be provided to the applicant with the full statutory six month period in which to prepare a response.

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Subject to the correction above, the applicant repeats, by reference, all of the commentary made in the previous response to office action of March 18, 2003.

4) 35 USC 112 - Formal Objections

Claim 4

The Examiner has again objected to the wording of claim 4, although on new grounds. In the Examiner's view, claim 4 is indefinite. The Examiner suggests that the term "a pivot pin" in line 4 of the claim be replaced by the term --- another pivot pin ---, and that the term "a collar" in line 4 be replaced by --- another collar ---.

The applicant again respectfully traverses the Examiner's rejection.

The applicant recognizes that the Examiner has now withdrawn his former formal rejection of claim 4. While the applicant appreciates the Examiner's thoughtfulness and helpfulness in suggesting possible alternative wording for claim 4, the applicant nonetheless respectfully submits that (a) the phrasing of the claim is grammatically correct as it stands; and (b) the suggestions proposed by the Examiner, if employed, would introduce grammatical errors into the claim.

The first branch of a *Markush* claim is not an antecedent of the second, or any subsequent branch of the claim. Therefore, logic requires that, for there to be "another" pivot pin, there must first be "a" pivot pin from which the second pin can be "an other". However, that is neither the grammatical structure nor the intent of the organization of the branches of *Markush* language in general or of the claim in question in particular. Similarly, for there to be "another" collar, there would first have to be "a" collar from which the word "another" could take meaning. Therefore, to do as the Examiner suggests would, unavoidably, add two grammatical errors to the claim.

As noted, the applicant respectfully submits that the claim is correct as it stands.

However, if the Examiner continues to be of the opinion that there is a grammatical error in the claim, and if the Examiner can explain, according to standard rules of English grammar, where there is an error in the grammatical structure of the claim, the applicant will gladly amend the claim to remove any such error identified by the Examiner.

5) Rejections Under 35 U.S.C. 102 - Anticipation

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(i) Test for Anticipation

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

(ii) U.S. Patent 3,161,153 of Johnson

The applicant notes that the Examiner has now withdrawn the former rejections based on US Patent 3,161,153 of Johnson.

iii) US Patent 5,782,187 of Black, Jr.

The Examiner has again rejected claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 as being anticipated by Black, Jr., et al.

The test for anticipation is stated above. It is a very high test. It requires that the Examiner show all of the elements of the claim in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. Consider, first, claim 3.

I) The claim is premised on the existence of bridge plates that span the gap between the coupler ends of the two rail road cars. Black neither shows nor describes bridge plates at the coupler ends of his rail road car.

II) The claim is premised on the idea that the bridge plate can be disengaged from the coupler end of the second rail road car. There is nothing in Black that shows this capability.

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To suggest that with "proper tooling" Black's internal plates can be disengaged (a) is pure conjecture, contrary to *Datascope*, supra.; and (b) is to supply information that is clearly not found in the reference as required by *Structural Rubber Products* and *Kohle*, supra.

III) The claim is premised on the idea that the bridge plate can be moved from a longitudinal orientation to a cross-wise orientation. There is nothing in Black that suggests that Black's plates are, ever have been, or ever will be, movable between a longitudinal position and a cross-wise position.

At no point has the Examiner explained how, or where, there is a basis in Black for the contention that Black's internal bridge plates are intended to be "disengageable" in any reasonable sense.

At no point has the Examiner explained where there is any basis in Black (as required in an anticipatory reference) for the statement "if proper tooling is available".

At no point has the Examiner explained where there is any basis in Black for the statement that "said fitting permitting movement in a cross-wise orientation" (In fact, the actual claim language is "said fitting permitting movement of said beam ... to a cross-wise orientation ..." i.e., the adjective "cross-wise" modifies the noun "orientation", rather than the noun "movement" it is not the movement that is said to be cross-wise, but the orientation of the beam.)

IV) Summary Re: Anticipation

The test for anticipation is simply not satisfied by Black.

To make this abundantly clear, the applicant has already requested that the Examiner use the format set out in *Re: Rozzi* and in *Ex Parte Braekin*. This step would conclusively reveal the lack of foundation of the rejection.

In conclusion, the applicant submits that none of the rejections of claim 3 or any claim dependent from claim 3 under 35 USC 102 made on the basis of US Patent 5,782,187 of Black, Jr., et al., are supportable. The applicant respectfully requests that the rejections be withdrawn.

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V) Claim 13 and Claims 14 - 15 Dependent Therefrom

In the context of Claim 13, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars where the bridge plates are disengageable from the adjacent railroad car.

The applicant respectfully requests that the rejections of claims 13 to 15 under 35 USC 102 in light of Black be withdrawn.

VI) Claims 20 and 23

In the context of Claims 20 and 23, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars where the bridge plates are disengageable from the adjacent railroad car.

The applicant respectfully requests that the rejections of claims 20 and 23 under 35 USC 102 in light of Black be withdrawn.

VII) Claim 24 and claim 25, 26 and 29 - 32 dependent therefrom

In the context of Claims 24, 25, 26 and 29 - 32, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars where the bridge plates are disengageable from the adjacent railroad car.

The applicant respectfully requests that the rejections of claims 24 - 26 and 29 - 32 under 35 USC 102 in light of Black be withdrawn.

6) Claim Rejections Under 35 U.S.C. 103 - Obviousness - Law

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In the interest of brevity, the applicant hereby repeats, and incorporates by reference, the statements of the law of the Response to Office Action of March 18, 2003.

7) The Rejections

(i) The applicant appreciates the withdrawal of the former rejections based on the Johnson reference and the Johnson reference in light of Russel.

(ii) The applicant appreciates the withdrawal of the former rejections based on the Black reference in view of the Bell reference as indicated at page 6, item 4.

(iii) Commentary re: Combination of US Patent 5,782,187 of Black, Jr., et al., and US Patent 3,195,478 of Thompson

The Examiner has cited the combination of Black, Jr., et al., and Thompson, newly against claim 8, and once again against claims 12, 18 and 28. According to the Examiner, Black teaches all of the limitations of claims 12, 18 and 28 except for (a) a railroad car bridge plate having traction bars on the upper surface and (b) a handgrab mounted thereto.

Curiously, while indicating that the claims have been rejected on the basis of Black in view of Thompson, the basis of the rejection then discusses Bell at rather greater length than Thompson. The applicant respectfully submits that this is in error, and respectfully requests that the Examiner confirm that the Examiner no longer relies upon the Bell reference in any of the current rejections.

The applicant also notes that if the portions of the commentary that discuss Bell are removed, there is nothing left on which to support a rejection of claim 8. As such, claim 8 should be allowed.

In any event, if the Examiner does rely on the Bell reference, the applicant repeats, and incorporates by reference the applicant's former commentary of the response of March 18, 2003 with regard to the Bell reference. That is, the Bell reference simply does not show or describe "traction bars", whether in Figure 1, or at col. 1 lines 60 - 67 or at col. 2 lines 49 - 51.

(iv) Commentary on Thompson '478

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The Examiner continues to contend that it would have been obvious to one of ordinary skill in the art to modify the bridge plate of Black, Jr., et al., to include the use of a handgrab as taught by Thompson.

As a preliminary matter, for the reasons discussed above, the applicant traverses the contention that Black teaches all of the limitations of claims 12, 18 and 28 except traction bars and a handgrab. However, even if it were true, (which it is not), the rejection would fail for lack of motivation, suggestion or incentive to combine.

The bridge plate construction of Thompson is clearly neither designed, nor intended, to remain in a position spanning two railroad cars during transit. In column 2, lines 19-21, among the objects of his invention, Thompson states:

"...which bridge plate and which bridge plate supports are adapted to be swung from a loading position to a transit position."

Further, as illustrated in Figure 3 and described at column 3 lines 45- 50,

"which bridge plate is pivotally mounted...for swinging movement between a generally horizontal loading position and a generally vertical transit position."

(v) No Suggestion Motivation or Incentive Demonstrated

The applicant notes that the Examiner has not identified any feature in any of the cited references from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine the cited references to arrive at the invention of any of claims 12, 18 and 28. As such no *prima facie* ground for rejection has been established under 35 USC 103. On that ground alone, if no other, the applicant respectfully submits that it is entitled to request withdrawal of the current rejection of claims 8, 12, 18 and 28.

(vi) No Reason to Combine

Thompson's handgrabs are intended for use in swinging the plate into a vertical position for transit. Inasmuch as the bridge plates of Black, Jr. are apparently intended to stay in place spanning the articulated connector between two rail car units, what would Thompson's handgrabs be used for on Black's internal bridge plates? The Examiner has not pointed to any explanation in the objective art of record of why a Black's internal bridge plates would require.



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or benefit from having, a handgrab. The applicant submits that a person of ordinary skill in the art would not be motivated to modify Black, Jr., to include the use of a handgrab, since this modification would not appear to provide any advantage to Black, Jr.

In the event that the Examiner seeks to maintain the rejection, the Applicant specifically requests that, in accordance with *In Re Kotzab*, the Examiner demonstrate where in the objective art of record in this case, there is an explanation of why a person skilled in the art would be motivated to make the proposed combination.

(vii) Thompson Teaches Against the Invention

To the extent that any current rejection under 35 USC 103 employs Thompson, and given that Thompson expressly teaches away from leaving the bridge plates in place during train operation, the applicant submits that no rejection under 35 USC 103 is supported by Thompson.

(viii) Black, Jr. and Thompson: References Teach in Opposite Directions-  
No Motivation to Combine

Even on the Examiner's own characterisation of Black Jr. (which the applicant traverses), Black Jr. shows bridge plates, albeit internal bridge plates, that stay in place during train operation.

By contrast, Thompson (a) shows (b) includes in the objects of his invention; and (c) claims, bridge plates that are to be raised to a vertical position for transit.

Since, if anything, the cited references teach in opposite directions, the applicant submits that no motivation to combine the two references can be found. As such, applicant submits that no basis for a *prima facie* rejection under 35 USC 103 has been established. Therefore the applicant respectfully requests withdrawal of the rejections under 35 USC 103.

8) The Examiner's Reply Commentary

The Examiner has made the following commentary:

"Applicant's arguments filed 03/24/03 have been fully considered but they are not persuasive."

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"A. Summary of applicant's argument"

"In the amendment, applicant traversed the rejection of the newly amended claims 3 - 10, 12 - 15, 18, 20, 23 - 26, 28 - 32 for the following reasons:

"2. The reference cited in the 102 rejection, Black Jr et al, fails to meet the limitations of the claims as it disclose permanently mounted bridge plates mounted between railroad cars."

"2. In response to applicant's argument number two, it must be recognized that Black Jr et al meet all the limitations of claims 3 - 7, 9 - 10, 13 - 15, 20, 23, 24 - 26, 29 - 32 as explained above since nowhere in Black Jr et al reference that the recitation of permanently mounted bridge plates is found as argued by applicant. Black Jr et al disclose bridge plates that are held stationary in operation to span the gap between two railroad cars, and the connection between the bridge plates (32) and the railroad car (22) is shown in Figs. 8 - 9. This connection is in no way a permanent connection as argued by applicant. The connection is such that the beam is disengageable from the railroad car whenever needed as explained above."

9) Rebuttal of Examiner's Commentary

The applicant disagrees with many parts of the Examiner's commentary, starting with the bold, and incorrect, assertion that "it must be recognized that Black Jr et al meet all of the limitations of claims 3 - 7". Black does not meet the limitations of the claims 3 - 7, as discussed at length both in this response and previously.

(I) The first point is that the claim is based on a connection at (a) the coupled ends of (b) two railroad cars. The applicant discussed this, at length, in the second and third full paragraphs at page 7 of the applicant's Response to Office Action of March 18, 2003, as follows:

Figures 1-8 of Black, Jr., cited by the Examiner, show an internal bridge plate. They do not reveal anything about the coupler end bridge plates. The Abstract makes no reference whatsoever to coupler end bridge plates. Indeed, the Abstract makes it abundantly clear that the bridge plates cited by the Examiner are "over the articulation between interconnected railway car units". The

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Examiner has not identified where in the vast amount of text in col. 1 - 2 lines 1 - 67 there is support for the Examiner's position.

In this regard, the applicant specifically notes that the Examiner's description in the Examiner's report mailed October 18, 2002 is incorrect in stating that Black, Jr., shows "... a beam 32 locatable in a longitudinal orientation of sufficient length to span a gap between a pair of adjacent railroad cars (22a, 22b), ..." Items 22a and 22b are not adjacent rail road cars. On the contrary, car units 22a and 22b are units of a single articulated rail road car, 22 as plainly indicated by Black, Jr., at, for example, col. 4, lines 1-7. The Examiner's attention is also drawn to Figures 1 and 2 of Black, Jr., which show a single railway truck supporting the two interconnected units 22a and 22b."

The Examiner has not responded to this argument. Specifically:

- 1) The Examiner has not acknowledged that Black items 22a and 22b are units of a single articulated railroad car, not two railroad cars.
- 2) The Examiner has not acknowledged that Black does not show coupler end bridge plates.
- 3) The Examiner has not acknowledged that Black item 32 is not a coupler end bridge plate.

The Examiner has not addressed any of these points, although they were clearly raised in the applicant's response.

(II) Burden of Proof Lies on the Commissioner

Leaving aside the fact that Black neither shows two rail road cars coupled together, nor shows coupler end bridge plates, the Examiner has suggested that Black's internal bridge plates 34 have fittings that are "disengageable". In dismissing the Applicant's argument, the Examiner has stated, *inter alia*:

- (a) "... since nowhere in Black Jr et al reference that the recitation or permanently mounted bridge plates is found, as argued by the Applicant."

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(b) "... and one of the pivot pins being disengageable if proper tooling is available to loosen pin 105 from the collars as shown in fig. 8."

(c) "This connection is in no way a permanent connection..."

Phrase (a) appears to indicate that the Examiner may not appreciate that the onus of establishing the basis for the rejection lies on the Commissioner.

The issue is whether the reference shows a bridge plate that is "disengageable". In order to sustain the rejection under 35 USC 102, the Commissioner bears a positive burden to demonstrate that this feature is clearly shown in the reference. By contrast, there is no burden on the applicant to show that it is not disengageable. However, to the extent that it can be demonstrated that Black does show a permanent bridge plate installation, it clearly cannot be showing a "disengageable" installation, and such a demonstration would be sufficient to refute the rejection.

(III) Bridge Plates Are Disengageable "if proper tooling is provided".

There are a number of issues arising out of this statement.

First, if a rejection is to be made under 35 USC 102, then a basis for this "proper tooling" comment must somehow be present in the reference. Clearly, there is not.

Second, a rejection under 35 USC 102 cannot be based on conjecture. (See *Datascope, supra*). The "proper tooling" statement is one of pure conjecture.

Third, a rejection cannot be based on unsupported conclusory statements by an Examiner. This statement concerning "proper tooling" is unsupported by anything in the evidence of record in this case. Thus far, contrary to the CAFC ruling of *In re Lee*, the Examiner has not identified anything in the objective art of record in this case, whether in Black or in any other reference, to support this "proper tooling" statement.

Fourth, the Examiner's statement relies on the assumption that the ability to dismantle the bridge plate is equivalent to being "disengageable". The applicant respectfully submits that grounds for this assumption have not been demonstrated in the objective evidence of record in the case. By

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way of example, with "proper tooling" (i.e., in the nature of a cutting torch) the center sill, or the main bolster, can be removed from the car. Yet that would hardly make the center sill or the main bolster "disengageable" in any reasonable meaning of the word. The applicant respectfully submits that a person skilled in the art, having no knowledge of the present application, but being aware of Black, could not reasonably be expected to understand that the word "disengageable" encompasses assuming that persons skilled in the art would take it upon themselves to obtain "proper tooling" to dismantle Black's apparatus, or to conclude that because Black's apparatus can, ultimately, be dismantled, that the feature is therefore "disengageable".

More importantly, there is no indication in Black that the parts discussed by the Examiner are intended to be taken apart after they have been assembled, nor is there any indication that, as an ordinary incident of daily operation, they are intended to be taken apart, nor that it is desirable for them to be taken apart, on a casual basis to permit the bridge plates to be disengaged.

If the Examiner is unwilling to concede this point, the applicant respectfully requests that the Examiner demonstrate, by column and line number or by Figure and item number, where in the Black reference or any other, there is any indication that the features identified by the Examiner are (a) intended to be taken apart after assembly; or (b) are intended to be dismantled as an ordinary incident of operation to permit plates 32 to be disengaged.

Fifth, the Examiner has not demonstrated a suggestion in the art that it would be desirable to dismantle Black's apparatus. That is, the Examiner contends that Black's apparatus can be taken apart, thus yielding (in the Examiner's view) the presently claimed invention. Yet the apparatus that the Examiner proposes to dismantle is part of Black's claimed invention. The applicant respectfully submits that there is no reason why a person skilled in the art would perceive it to be desirable to dismantle Black's invention, whether with "proper tooling" or without. The applicant respectfully submits that a rejection that relies on the ability to dismantle part of the claimed invention of the cited prior art reference is not sound. (See: *In re Gordon*).

In summary, the present rejection relies not merely on (a) an assumption of the ability to dismantle Black's apparatus, but, additionally, on (b) the assumption that Black's apparatus is *intended* to be dismantled in the ordinary course; on (c) the assumptions that a person skilled in the art would *infer* the ability to dismantle Black's apparatus, on (d) the assumption that a person skilled in the art would *infer* that Black's apparatus is intended to be dismantled as an ordinary incident of

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operation; on (c) the assumption that a person skilled in the art would infer the *desirability* of being able to dismantle Black's apparatus; and finally on (f) the assumption that the person skilled in the art would *construe* all of these things to mean "disengageable".

The applicant respectfully submits that a rejection made on this basis clearly does not satisfy the test for anticipation under 35 USC 102.

10) Further Commentary by Examiner

In dismissing the Applicant's arguments pertaining to the rejection under 35 USC 103 based on the combination of Thompson and Black, the Examiner writes:

"A Summary of the applicant's argument ...

"5. The combination rejection of Black Jr et al and Thompson is improper as Black Jr et al is designed to remain in position while Thompson is designed to remain in position. [sic].

"B Response to applicant's argument

"5. Regarding applicant's argument number 5, it should be noted that the combination rejection was simply based on a teaching of a handle that is disclosed by the prior art of record, Thompson, which disclose a handle attached to the side of a bridge plate for the purpose of moving the plate out of position. A person of ordinary skill in the art would have been motivated to incorporate the handle of Thompson into Black Jr et al for the purpose of rotating the bridge plate out of position during service of the railroad cars and come up with the claimed invention. Applicant's argument that the two arts are in the opposite direction is weak to overcome the fact that one of ordinary skill in the art would incorporate a handle into Black Jr et al."

Further Commentary on Thompson

Thompson has a handle to permit Thompson's bridge plate to be raised and lowered between "a loading position and a transit position" (Thompson col. 2, lines 14 - 21: "It is an object of the present invention to provide ... a bridge plate ... at the end of the flat car ... which bridge plates are adapted to be swung from a loading position to a transit position." (I.e., the loading position, across the gap, is not the transit position - the antithesis of staying in place during transit).

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First, Black does not have, and does not need, a handle to swing the plate, because Black's internal bridge plates are apparently not intended to be, and may not be able to be, swung to a cross-wise position.

Second, whether Thompson shows a handle or not, the Examiner has not demonstrated any reason why anyone would add a handle to Black's internal bridge plates. There is no motivation.

The Examiner cites "... the purpose of rotating the bridge plate out of position during service..." But what is there, in Black or any other art of record in this case, that suggests any reason for rotating Black's internal bridge plate out of position during service? Why would anyone do that? What reason would there be? No explanation is provided in the Office Action.

Third, Thompson clearly teaches away from the present invention by teaching that it is "an object" of his invention to provide a bridge plate that is movable to a vertical transit position, not one that can stay in place spanning the gap between the cars during transit. (See also Thompson col. 3 lines 45 et seq., noted above).

The Examiner has not responded to these points.

11) Hindsight Analysis

The Examiner comments that "... it should be noted that the combination rejection was simply based on a teaching of a handle that is disclosed by the prior art of record, Thompson, which disclose a handle attached to the side of a bridge plate for the purpose of moving the plate out of position."

This is a revealing admission by the Examiner.

(I) First, it is plainly evident from this commentary that the Examiner has engaged in a process of picking and choosing claim features from prior art references, using the applicant's claims as a road map. This is an exercise in hindsight re-construction of the invention. It is precisely this kind of exercise that the law forbids. See, for example:

A. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065 (CA FC 2000)

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"Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.

*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). *We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."* *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). (Emphasis Added).

"Our case law makes clear that the best defence against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability the essence of hindsight." *Id.*

B. *Henkel Corp. v. Coral Inc.* (DC NIll) 21 USPQ2d 1081 (12/28/1990)

"Under §103, the invention must be shown to have been obvious by the suggestions of the prior art itself, and without resort to the "road map" approach of utilizing the patent in suit. The Federal Circuit stated:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. ... One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

*In re Fine*, 837 F.2d 1071, 1075 [ 5 USPQ2d 1596 ] (Fed. Cir. 1988) ( quoting *W.L. Gore Associates Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 [ 220 USPQ 303 ] (Fed. Cir. 1983)), *Accord Grain Processing Corp. v. American Maize Prod. Co.*, 840 F.2d 902, 907 [ 5 USPQ2d 1788 ] (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit"); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561.



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1568, 1574-75 [ 1 USPQ2d 1593 ] (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987); Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012 [ 217 USPQ 193 ] (Fed. Cir. 1983).

*Henkel*, footnote 34: "In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, *the references "must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention". Akzo N.V. v. U.S. Int'l Trade Comm'n* 808 F.2d 1471, 1481 (Fed. Cir. 1986) .... *Panduit v. Dennison Mfg. Co.*, 810 F.2d 1562, 1568 ... (a prior art reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the inventions in suit"). ... In this case, the references argued by Coral are in many ways antithetical in concept to the '661 invention and to each other, and, thus, do not form a basis for finding the '661 patent obvious." (Emphasis added).

C. *American Medical Systems Inc. v. Medical Engineering Corp.* (DC EWis) 26 USPQ2d 1081 (6/25/1992) at pp 1090 - 1091:

" ..., *the issue of motivation to combine features of references is one that is assessed on the teaching of the references as a whole. It is improper to engage in an exercise of picking and choosing.*" (Emphasis added).

(II) Second, it illustrates, again, that the requirement to show an objective basis of suggestive motivation, or incentive, in the references to form the combination has been ignored. The Examiner's own confession, quoted above, makes it abundantly clear that the present rejections based on Black in view of Thompson have employed the hindsight shopping list approach in which the present applicant's claims have served as a roadmap, with complete disregard to the requirement that there be an objective motivation, suggestion, or incentive to combine.

(III) Third, again, lacking evidence in the references to support the combination, the Examiner states, "... a person of ordinary skill in the art would have been motivated to incorporate the handle of Thompson into Black Jr. et al for the purpose of rotating the bridge plate ..."

There is no basis of support identified for this statement. On the contrary, it is the epitome of a bald, unsupported conclusory statement by an Examiner. "Broad conclusory statements

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regarding the teaching of multiple references, standing alone, are not evidence." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

The applicant therefore respectfully submits that the approach employed by the Examiner is forbidden by binding precedent, and any rejection based thereon can not stand. In the event that the Examiner seeks to maintain the current rejections of the claims, the Examiner is specifically requested to address the foregoing points, and to explain how and why the rejections can be maintained in light of his own admission, quoted above, and the cited case law, also quoted above.

12) Statements of The Law

Previous office actions in this matter contained purported statements of the law that were without foundation in the statute, the regulations, or the caselaw. Indeed, the applicant respectfully submitted that some of the statements were either incomprehensible, or directly contrary to the law. Inasmuch as those points were, and are, fundamental to the examining process, the applicant respectfully and explicitly requested specific clarification of those points. No such response has been provided by the Examiner.

The applicant requested a full explanation of those statements in the response to Office Action of August 26, 2002. The applicant again requested an explanation of those statements in the Response to Office Action of March 18, 2003. Now, for a third time, the applicant requests a detailed explanation of the statements of the law formerly made by the Examiner.

To date, there is no evidence to show that the Examiner is applying the law, or attempting to apply the law, in any manner different than that formerly, and erroneously, cited. It appears that the Examiner is still attempting to apply the law in an incorrect manner. The applicant therefore respectfully requests either (a) an explanation of the Examiner's former commentary; or (b) (i) an acknowledgement that the Examiner's former statements of the law were incorrect; and (ii) a demonstration that the Examiner now has a correct understanding of the law, MPEP 2142, and *In re Lee*. To date there has been no such demonstration, and it clearly cannot be inferred from the Office Action of October 18, 2002 or from the Office Action of May 13, 2003.

In summary, for all of the reasons set out above, the applicant respectfully submits that the Examiner has not discharged his duties under MPEP 707.07.

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Conclusion

In view of the foregoing arguments, the applicant submits that claims 3 - 46 presently pending in this case are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

Respectfully submitted,



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